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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|--------------------|-------------|-----------------------|---------------------|

09/461,646 12/14/99 GROTENDORST

G FIBRO1130

EXAMINER

HM12/0228

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ART OBJECTOR PAPER NUMBER

DATE MAILED: 1647

02/28/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 11/30/00

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-14 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

**Part III: Detailed Office Action**

**Notice:** Effective June 18, 2000, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1647.

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**Restriction Requirement:**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to CTGF fragments and nucleic acids encoding such, classified in class 536, subclass 23.1.
- 10 II. Claim 6, drawn to antibodies, classified in class 530, subclass 387.9.
- III. Claims 7 and 11, drawn to antisense nucleic acids and use thereof, classified in class 424, subclass 139.1.
- IV. Claims 8-10, drawn to methods of treatment using antibodies, classified in class 424, subclass 139.1.
- 15 V. Claims 12-14, drawn to cellular proliferation assays using CTGF fragments, classified in class 435, subclass 7.2.

The inventions are distinct, each from the other because:

20 The proteins of Invention I are related to the antibodies of Invention II by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary steric complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or in assays for the identification of agonists or antagonists of the CTGF receptor.

25 Some of the antisense oligonucleotides of Invention III may be related to the nucleic acids of Invention I by virtue of being subsequences of longer disclosed sequences. However, these inventions are patentably distinct both because the nucleic acids of Invention I are not required for

Invention III, and because they are used in materially different processes which processes are completely different and distinct. The arts of antisense therapy and recombinant production of proteins are separate and distinct, and require non-coextensive searches.

5 The protein and nucleic acid products of Invention I and the products of Invention II are separate and distinct from the methods of Invention IV, wherein the products are neither made be nor used in the methods, and wherein each requires a separate search.

10 Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins may be used as antigens for the production of the antibodies of invention II, or directly as a therapeutic agent.

15 The products of Inventions II and III are separate and distinct, each having a distinct physical and chemical structure, different means of manufacture, and different uses. Accordingly, restriction is proper.

20 Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products may be used for the purification of the proteins of Invention I.

The compositions of Invention III are separate and distinct from each of the methods of Inventions IV and V, wherein the products are neither made be nor used in the methods, and wherein each requires a separate search.

25 The methods of groups IV and V are separate and distinct, one from the other, because they utilize different active agents and method steps to achieve dissimilar ends. Accordingly, the searches for the two methods are not coextensive, and restriction is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate

Serial Number 09/461646  
Art Unit 1647

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status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

**Advisory Information:**

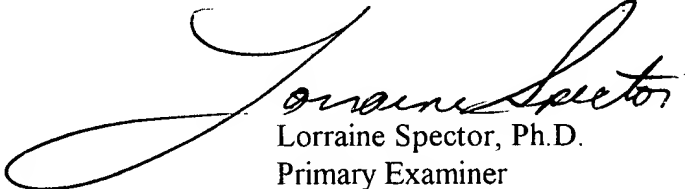
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 5:30 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached at (703)308-4623.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to (703) 305-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. **Please** advise the Examiner at the telephone number above when an informal fax is being transmitted.

  
Lorraine Spector, Ph.D.  
Primary Examiner

LMS  
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2/28/01